

Application No. 10/783,560
Amendment Under 37 C.F.R. § 1.111 dated June 28, 2006
Reply to Office Action mailed December 29, 2005

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed December 29, 2005. Claims 3 and 13 are amended and new claims 21 and 22 have been added. Claims 1-22 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. Allowed Subject Matter

The Examiner has indicated that claims 3 and 13 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicants have rewritten claim claims 3 and 13 in an independent format so as to include all of the limitations of the base claim. In particular, the scope of claims 3 and 13 have not been narrowed in any way so as to overcome any prior art, but have merely been rewritten in independent format. As acknowledged by the Examiner, these claims are patentably distinct from the prior art, and are now in condition for allowance. Applicants wish to thank the Examiner for the careful review and allowance of claims 3 and 13.

The Applicant's submit the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. Applicant agrees with the Examiner that the claimed invention of claims 3 and 13 is patentable over the prior art, but respectfully disagrees with the Examiners statement of reasons for allowance as set forth in Office Action. Applicant submits that it is the claim as a whole, rather than any particular

Application No. 10/783,560
Amendment Under 37 C.F.R. § 1.111 dated June 28, 2006
Reply to Office Action mailed December 29, 2005

limitation, that makes each of the claims allowable. No single limitation should be construed as the reason for allowance of a claim because it is each of the elements of the claim that makes it allowable. Therefore, Applicant's do not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claims allowable and do not make any admission or concession concerning the Examiner's statement in the Office Action.

II. CLAIM REJECTIONS

A. Rejection Under 35 U.S.C. §102(b or e)

The Examiner rejects claims 1, 2, 4-5, 9-11, and 16 under 35 U.S.C. § 102(b) as being anticipated by *Ackerman et al.* (United States Patent No. 6,291,813). Because *Ackerman* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

A claim is anticipated under 35 U.S.C. § 102(b) or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. Manual of Patent Examining Procedure ("MPEP") § 2131. It is well established that "every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines." *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970); *See also In re Wilson*, 165 USPQ 494 (CCPA 1970) ("all words in a claim must be considered in judging the patentability of that claim against the prior art").

Regarding the rejection of independent claims 1 and 16, according to the Examiner on page 2, *Ackerman* discloses the element, "calculating an average wavelength drift based at least in part on a differential wavelength value detected between the identified corresponding optical signal wavelengths over the identified two or more time intervals (see column 3, line 57-68)...." Regarding the rejection of independent claim 9, the Examiner relies on the same portion of *Ackerman* to reject a similar element of claim 9.

Application No. 10/783,560
Amendment Under 37 C.F.R. § 1.111 dated June 28, 2006
Reply to Office Action mailed December 29, 2005

However, in direct contrast to the assertions of the Office Action, column 3, lines 57-68 of Ackerman relate to normalizing a reference signal, and the Examiner has not shown that an average wavelength drift is calculated during normalization as required by the claims. More specifically, column 3, lines 57-68 recites the following:

By detecting and conditioning the two signals, it is possible to calculate a difference between these two signals, which will alternate in polarity as wavelength is swept as shown in FIG. 1. Preferably, the etalon signal 10 is normalized to the reference signal 11 if the optical output intensity is also a function of wavelength. The reason for performing the normalizing process is as follows. As the laser is heated or cooled to change its wavelength, the output intensity of the laser also varies (e.g., heating causes a reduction in output power). With the etalon response curve being a function of both optical power and wavelength, this change

The Examiner has not set forth where in this passage an average wavelength drift is calculated as required for a *prima facie* case of anticipation for claims 1, 9, and 16. In fact, this portion relied upon in the Office Action merely relates to normalizing an etalon signal 10 with a reference signal 11 not requiring the calculation of an average wavelength drift, but rather, merely requires calculation of a difference between the two signals (see col. 3, lines 57-58) for normalization. Therefore a *prima facie* case of anticipation has not been set forth and the Applicants respectfully request that the rejection of claims 1, 9, and 16 be withdrawn.

Claims 2-8 depend from claim 1, claims 10-15 depend from claim 9, and claims 17-20 depend from claim 16 and include each element of the claim from which they depend. As such, the Applicants respectfully request that the rejections of claims 2-8, 10-15, and 17-20 be withdrawn at least for the same reasons as the claim from which they depend.

The Examiner rejects claims 1, 10-12, and 16 under 35 U.S.C. § 102(e)¹ as being anticipated by *Kish, Jr. et al.* (United States Patent Publication No. 2005/0018721). Because *Kish* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

Regarding claims 1 and 16, according to the Examiner on page 4 of the Office Action, *Kish* teaches in Figures 11 and 12, "calculating an average wavelength drift based at least in part

¹ Because *Kish* is only citable under 35 U.S.C. § 102(e) Applicants do not admit that *Kish* is in fact prior art to the claimed invention but reserve the right to swear behind *Kish* if necessary to remove it as a reference.

Application No. 10/783,560
Amendment Under 37 C.F.R. § 1.111 dated June 28, 2006
Reply to Office Action mailed December 29, 2005

on a differential wavelength value detected between the identified corresponding optical signal wavelengths over the identified two or more intervals....” The Examiner does not, however, give any indication where in Figures 11 and 12 this calculation of an average wavelength drift is taught. In fact, Kish includes a Figure 12A and a Figure 12B, thus the Examiner has only expressed a vague reference to three Figures (i.e. Figures 11, 12A, and 12B) to support the assertion that Kish teaches this element of claim 1 and 16. 37 CFR 1.104 requires, “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” Thus, a *prima facie* case of anticipation has not been set forth according to the specificity required by 27 CFR 1.104. Moreover, after a review of Figures 11, 12A, and 12B, the Applicant is unable to identify calculation of an average wavelength drift as alleged by the Examiner. As such, the Applicants respectfully request that the rejection of claims 1 and 16 be withdrawn or an indication of where the elements of the claims are taught be clearly explained.

Claims 2-8 depend from claim 1 and claims 17-20 depend from claim 16 and include each element of the claim from which they depend. As such, the Applicants respectfully request that the rejections of claims 2-8 and 17-20 be withdrawn at least for the same reasons as the claim from which they depend.

Regarding the rejection of claims 10-12 under Kish, the Examiner has failed to set forth a proper *prima facie* case of anticipation because the Examiner has failed to address the elements of claim 9 from which claims 10-12 depend. Dependent claims incorporate every element of the claim(s) from which they depend. As discussed above, “[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Quite simply, the Examiner has only addressed a single element of each of claims 10-12. Thus, a *prima facie* case of anticipation has not been met and the Applicant respectfully requests that the rejection of claims 10-12 be withdrawn.

Application No. 10/783,560
Amendment Under 37 C.F.R. § 1.111 dated June 28, 2006
Reply to Office Action mailed December 29, 2005

The Examiner rejects claims 1, 10-12, and 16 under 35 U.S.C. § 102(e)² as being anticipated by *Nasu et al.* (United States Patent No. 6,856,633). Because *Nasu* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

Regarding the rejections of claims 1, 9, and 16, according to the Examiner on pages 4 and 5 of the Office Action, *Nasu* teaches the calculation of an average wavelength drift in columns 4, 16, 25, and Figure 29. On the outset, the Applicants note that column 25 does not exist in *Nasu*. Moreover, a review of columns 4, 16, 25, and Figure 29 does not reveal such a calculation of an average wavelength drift in combination with every other element set forth in independent claims 1 and 16. As discussed above, 37 CFR 1.104 requires, "[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." The rejection has not met the level of clarity required by 37 CFR 1.104. Therefore, a *prima facie* case of anticipation has not been set forth and the Applicants request that the rejection of claims 1, 9, and 16 be withdrawn.

Moreover, as discussed above, 37 CFR 1.104 requires, "[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." The rejection has not met the level of clarity required by 37 CFR 1.104. Therefore, a *prima facie* case of anticipation has not been set forth and the Applicants request that the rejection of claims 1, 9, and 16 be withdrawn.

Claims 2-8 depend from claim 1, claims 10-15 depend from claim 9, and claims 17-20 depend from claim 16. Each dependent claim includes every element of the claim from which it depends. As such, the Applicants respectfully request that the rejections of claims 2-8, 10-15, and 17-20 be withdrawn at least for the same reasons as the claims from which they depend.

² Because *Nasu* is only citable under 35 U.S.C. § 102(e) Applicants do not admit that *Nasu* is in fact prior art to the claimed invention but reserve the right to swear behind *Nasu* if necessary to remove it as a reference.

Application No. 10/783,560
Amendment Under 37 C.F.R. § 1.111 dated June 28, 2006
Reply to Office Action mailed December 29, 2005

B. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 6 and 19 under 35 U.S.C. § 103 as being unpatentable over *Nasu*. Claim 6 depends from claim 1 and claim 19 depends from claim 16. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, the Applicants request that the rejections of claims 6 and 19 be withdrawn at least for the same reasons as the claim from which they depend.

The Applicant also notes that the Examiner is relying on case law (i.e. *In re Boesch*) for the proposition that it "would have been obvious to one having ordinary skill in the art at the time of the invention was made to have different time intervals sampled...." To rely on legal precedent, the Examiner must show that the facts in the prior legal decision are sufficiently similar to those in this application. MPEP 2144.04. "[The Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Warner*, 154, USPQ 173, 178 (CCPA 1967). Thus, the Office Action has not set forth the factual basis requiring concrete evidence of record for a *prima facie* case of obviousness regarding claims 6 and 19. As such the Applicant requests that the rejection of claims 6 and 19 be withdrawn.

III. NEW CLAIMS

New claims 21 and 22 have been added and are novel and non-obvious over the references of record.

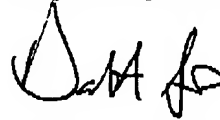
Application No. 10/783,560
Amendment Under 37 C.F.R. § 1.111 dated June 28, 2006
Reply to Office Action mailed December 29, 2005

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 28th day of June, 2006.

Respectfully submitted,



DAVID A. JONES
Registration No. 50,004
Attorney for Applicant
Customer No. 022913
Telephone: (801) 533-9800

W:\15436\253.88.2\ML0000003022V001.doc